

**REMARKS**

Claims 1-94 were pending in this case. The Office Action of April 15, 2004 stated that claims 1-23 are pending and that claims 24-94 are non-elected invention. Applicant is now canceling claims 24-94 without prejudice, as non-elected invention, while reserving the right to file any divisional patent application(s) thereon if Applicant so chooses. Applicant, however, is requesting the Examiner to reconsider and reinstate claims 24 and 25 in the presently prosecuted claims since they are dependent on claim 1 and are methods of treating hepatitis C virus using the compound of claim 1. This is a common practice with pharmaceutically useful compounds and such an action is earnestly requested.

The Examiner has kindly reminded Applicant about the requirements for claiming benefit of priority from the parent provisional application. Applicant sincerely appreciates the reminder and has included an Amendment to the Specification in this Response to claim priority from the provisional application, Serial No. 60/254,869 filed December 12, 2000.

Claims 1-23 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly "enablement" reasons. The Examiner states that the specification does not "reasonably provide enablement for all the compounds presented by the general structure formula (I) of claim 1". Page 5 of the instant Office Action. The Examiner cites the "need" for "undue experimentation" among the several reasons. This rejection is respectfully traversed for the following reasons:

Applicant, as the Examiner has pointed out, has disclosed in this case a number of compounds, by experimentation, activity data and individual structures, which all fall within the structure shown in general Formula I. Applicant believes that such an enormous and substantial amount of disclosure satisfies the enablement requirement quite well. "The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention. The law recognizes that patent specifications are written for those *skilled in the art*, and requires only that the inventor describe the "best mode" known at the time to him of making and using the invention." 35 U.S.C. § 112. Furthermore, there is a well-documented legal precedent to support

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Applicant's assertion that the enablement requirement is fully satisfied in the present case. "To be enabling under § 112, a patent must contain a description that enables one skilled in the art to make and use the claimed invention." *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 U.S.P.Q. (BNA) 409, 413 (Fed. Cir. 1984). "It is well established that a patent applicant is entitled to claim his invention generically, when he describes it sufficiently to meet the requirements of Section 112." *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 U.S.P.Q.2d (BNA) 1016, 1027 (Fed. Cir. 1991). "[I]t is not necessary that a patent applicant test all the embodiments of his invention" *In re Angstadt*, 537 F.2d 498, 502, 190 U.S.P.Q. (BNA) 214, 218 (CCPA 1976). "[N]ot every detail [of an invention need] be described [in patent specification], else patent specifications would turn into production specifications, which they were intended to be". *In re Gay*, 309 F.2d 769, 774, 135 U.S.P.Q. 311, 316 (C.C.P.A. 1962). "Nothing more than objective enablement is required, and therefore it is irrelevant whether [a] teaching is provided through broad terminology or illustrative examples." *In re Wright*, 999 F.2d 1557, 1561, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). Applicant believes that the vast amount of experimental details, compounds, variety of molecules and particulars that are provided in the present case are sufficient enough to fully satisfy the enablement requirement, and, therefore, respectfully requests withdrawal of the § 112, first paragraph rejection.

Claim 19 is cancelled without prejudice. Claim 20 is cancelled without prejudice, with the limitation of claim 20 now being incorporated into the amended claim 18. Claim 21 has been amended to recite its new dependency, while claim 22 has been amended to remove the word "still".

Claims 24-94 stand cancelled without prejudice as non-elected invention.


Claims 1 and 19-23 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/825,399. A Terminal Disclaimer is attached.

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There being no other rejections pending, Applicant believes that claims 1-23, (and claims 24-25 if they are reinstated), are in allowable condition. Such an action is earnestly requested. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,



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